

Appl. No. 09/804,973
Amdt. dated August 22, 2005
In response to Office Action mailed July 25, 2005

PATENT

REMARKS/ARGUMENTS

This Amendment/Election is responsive to the Office Action mailed on July 25, 2005. In this Amendment/Election, claims 56, 59, 61-67, 69-82, 89, 98, and 109-113 are canceled, and claims 114-126 are added so that claims 114-126 are pending and subject to examination.

In the Office Action, the Examiner requests an election of species, and lists various Groups of Figures at page 2 of the Office Action. In response, *Applicants elect Group II: Figures 11-13*. New claims 114-126 are readable thereon.

New independent claim 114 was drafted in view of a past conference with the Examiner. The submission of new independent claim 114 is not made to overcome any present prior art rejection. Applicants submit that claim 114, like the previously submitted claims, are clearly allowable over the prior art.

In a prior teleconference with the Examiner, the Examiner raised the issue of a possible rejection under 35 U.S.C. § 102(g) in view of U.S. Patent No. 5,381,685 ("the '685 patent"), because Mr. Gary L. Myers is not listed as a co-inventor on the present application, but is listed as a co-inventor on the '685 patent.

A rejection under 35 U.S.C. § 102(g) would not be appropriate in this application. 35 USC § 102(g) states:

A person shall be entitled to a patent unless--

during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

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Unlike the other sections of 35 U.S.C. § 102, 35 U.S.C. § 102(g) does not mention "patent applications", "patents" or even "printed publications". Accordingly, Applicants fail to understand how the '685 patent can form the basis for a rejection under 35 U.S.C. § 102(g). Should the Examiner believe that a rejection under § 102(g) is proper using a published patent, the Examiner is requested to explain where the statute authorizes this.

Nonetheless, Applicants submit that the omission of Mr. Myers as a co-inventor on the present application is believed to proper and his presence on the '685 patent is also proper. Attached hereto is a Declaration Regarding Nonjoinder of Inventors Under 37 CFR 1.48 that was filed in prior related application 07/824,967, filed on January 24, 1992. As stated at paragraph 7 of the Declaration, Mr. Myers' contribution to the prototype cylinder lock that was originally received from Mr. Carl and Mr. Zarnowitz included "modifications to a spring of a biased housing, as well as improvements to the cylinder lock. Many of the changes related to manufacturing, cost reduction and adapting the prototype to Fort Lock's manufacturing process." The "spring biased housing" feature appears to be claimed in claim 13 in the '685 patent (see c. 10, l. 66 of the '685 patent). Accordingly, it appears that Mr. Myers should be listed as a co-inventor on the '685 patent. However, in the present claims, a "spring biased housing" is not claimed. Accordingly, it is believed that Mr. Myers should not be listed as a co-inventor on the present application. To avoid any doubt as to whether or not Mr. Myers should be added as a co-inventor, the pending claims do not recite the word "spring". Applicants submit that since Mr. Myers did not invent any of the features in the presently pending claims, it is proper to not list him as a co-inventor.

The Examiner also mentioned that a rejection under 35 U.S.C. § 102(g) in view of the '685 patent was made in an Examiner's Answer in U.S. Patent Application No. 08/998,961, and that the Board of Patent Appeals and Interferences should have ruled on this rejection. Attached for the convenience of the Examiner is a copy of the Remand to the Examiner in 08/998,961. The Remand to the Examiner indicates that the Board of Patent Appeals and Interferences basically requested that the Examiner clarify each of the rejections made in the Examiner's Answer. The case was then allowed and a patent was issued. The Board of Patent

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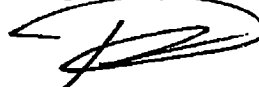
PATENT

Appeals and Interferences clearly did not validate a rejection under 35 U.S.C. § 102(g) based on the '685 Patent.

CONCLUSION

Applicants believe all claims now pending in this Application are in condition for allowance. Should any remaining issues preclude allowability in this application, the Examiner is requested to call the undersigned at 415-576-0200.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on

PATENT

Attorney Docket No. 14572-28

By _____
Jo Ann Dallara

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)

STEWART R. CARL, et al.)

Examiner: D. Boucher

Serial No.: 07/824,964)

Art Unit: 3508

Filed: January 24, 1992)

For: COMPUTER PHYSICAL SECURITY)
DEVICE)

Commissioner of Patents and Trademarks
Washington, D.C. 20231

DECLARATION REGARDING NONJOINDER OF INVENTORS UNDER 37 CFR 1.48

Sir:

We, Stewart R. Carl and Arthur H. Zarnowitz, being duly warned that willful false statements and the like are punishable by fine or imprisonment or both (18 U.S.C. 1001) and may jeopardize the validity of the patent application or any patent issuing thereon, state and declare as follows:

1. All statements herein made of our own knowledge are true and all statements made herein made on information and belief are believed to be true.
2. On or about February 14, 1991 we produced the first sketches for a computer physical security device embodying our invention.
3. On or about June 24, 1991 we produced the first engineering drawings for a computer physical security device embodying our invention.
4. Shortly after releasing the first engineering drawings, we issued the drawings to Mr. Myers and to our prototype shop.
5. Mr. Myers made some adjustments and modifications to our design as embodied in the prototype.
6. The fundamental aspects of the modified security device's operation and construction were unchanged from our initial engineering drawings.
7. Mr. Myers' contributions to the security device include modifications to a spring of the biased housing, as well as improvements to the cylindrical lock. Many of the changes

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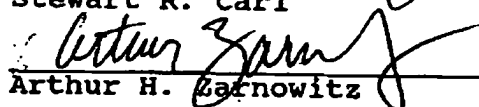
related to manufacturing, cost reduction and adapting the prototype to Fort Lock's manufacturing process.

8. When we executed our declaration for the subject patent on 22 January 1992, we each believed ourselves to be an original, first and joint inventor, as we still believe ourselves to be original, first and joint inventors.
9. Because we originated the idea of the computer physical security device and developed the prototype when we executed the declaration, we did not believe that Mr. Myers was an inventor as we understood the term at that time.
10. Since we did not believe that Mr. Myers was an inventor, we did not question the absence of his name from the declaration, or other places that provided a list of "inventors."
11. We had no cause to believe that our understanding of inventor was incorrect, or that Mr. Myers should be included as an inventor, until George Schwab contacted us regarding an Examiner's Action mailed 6 October 1992 regarding our application.
12. From an investigation of that Examiner's Action, we discovered that Mr. Myers had filed an application claiming portions of the physical security device that he believed he invented.
13. In the course of our discussions with Mr. Schwab, we reviewed the claims in light of our new understanding of the requirements to be included as an inventor in a patent application.
14. After a careful re-review of the pending claims, we now believe that Mr. Myers is an inventor of the subject matter included in at least one claim of the pending application.
15. Based upon the above statements, declarants believe that Gary L. Myers should be added as a joint inventor and hereby request that such action be taken.
16. The declarants have nothing further to say.

Dated: 3/15/93

Dated: 3/15/93


Stewart R. Carl


Arthur H. Gornowitz

23068-7019

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAR 29 2002

MDB&E

Ex parte WILLIAM R. MURRAY JR.,
STEWART R. CARL and ARTHUR H. ZARNOWITZ

Appeal No. 2001-1789
Application No. 08/998,961

MAILED

MAR 25 2002

ON BRIEF

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, FRANKFORT, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

Statute Cl. 9/25/02 od &

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR 1.196(a) and MPEP § 1211 for appropriate action with regard to the items listed below.

1. In reviewing the examiner's answer (Paper No. 14, mailed July 3, 2000), we note that the examiner has rejected claims 1, 2 and 5 through 15 on appeal under the "judicially created doctrine

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of double patenting over claims 12, 14, 15 and 18 of U.S. Patent No. 5,381,685 since the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent" (answer, pages 6-7) and also provisionally rejected claims 1 through 13 and 15 through 17 under the "judicially created doctrine of double patenting over claims 1-7 of copending Application No. 09/038668 (allowed) and [claims] 56-58, 63-67 of copending Application No. 08/138634 (now U.S. patent 6,000,251)" (answer, pages 7-8). In each instance, the examiner has cited In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) as support for the double patenting rejection. However, we note that MPEP § 804 (page 800-27) now sets forth that rejections based on In re Schneller "**will be rare**" and that the Technology Center (TC) Director must approve any such rejection. In order to ensure consistency in the application of this type of nonstatutory double patenting rejection, we REMAND the present application to the examiner to consider whether the above-noted nonstatutory double patenting rejections should be maintained and/or the more usual obviousness-type double patenting rejection entered.

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2. In addition, we have made note of the examiner's comments on page 10 of the answer (Footnote 1) concerning 35 U.S.C. § 112, second paragraph, problems in claim 1 on appeal created by entry of the amendment filed after final rejection. On remand, the examiner should explain what problems are present and make an appropriate rejection. At the same time, the examiner should consider a rejection of claim 10 on appeal under 35 U.S.C. § 112, second paragraph. Claim 10 is a method claim which is currently dependent from apparatus claim 8. It appears that claim 10 would most likely be dependent from method claim 9.

3. Regarding the examiner's rejections under 35 U.S.C. § 102, based on Carl '685, we note that appellants have argued that Carl '685 does not disclose or teach each and every limitation of the claimed invention. More specifically, appellants urge (brief, page 9) that Carl '685 does not teach any abutments or means that are independent from and proximately located to a security slot as defined in the claims on appeal. In this regard, note Figure 19 of the application and compare that

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to the examiner's position as set forth on pages 10-12 of the answer. Note also that claim 1 on appeal sets forth that the equipment to be secured includes "engagement members mounted on the outer surface of the wall proximate the slot" (emphasis added) and that claim 5 includes "an abutment mechanism projecting from the external wall [of the portable device] proximate the security slot" (emphasis added). We are at somewhat of a loss to understand how the internal walls of the slot (72) of Carl '685 can be responsive to the above-noted structure in appellants' claims 1 and 5, as has been urged by the examiner. The examiner should carefully assess the language of each of the claims on appeal and clearly set forth how the structure in Carl '685 corresponds, i.e., exactly how each of the rejected claims on appeal is readable on the structure of Carl '685. See particularly, MPEP § 1208, page 1200-19, where the examiner's obligations with regard to a rejection under 35 U.S.C. § 102 maintained in the examiner's answer are clearly spelled out.

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This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Aug. 2001. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

IRWIN CHARLES COHEN
Administrative Patent Judge

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Jennifer D. Bahr
JENNIFER D. BAHR
Administrative Patent Judge

BOARD OF PATENT
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Appeal No. 2001-1789
Application No. 08/998,961

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